

Appl. No. 09/869,476
Atty. Docket No. AA387
Amdt. dated 1/29/2004
Reply to Office Action of 10/01/2003
Customer No. 27752

REMARKS

Claims 11-23 are pending in the present application. No additional claims fee is believed to be due.

Claims 11-16 and 20-23 have been withdrawn as a result of an earlier restriction requirement.

Applicants traverse the Office Action's 35 U.S.C. sections 112 & 103 rejections and request reconsideration of election/restriction requirement under 35 U.S.C. sections 121 & 372.

Rejection Under 35 USC 112, First Paragraph

The Office Action rejects Claims 17-19 under 35 U.S.C. section 112, second paragraph for the use of the term "essentially free." Applicants respectfully traverse this rejection.

Applicants point out that Claim 17 (per Applicants' 9/24/2003 Amendment) specifically claims, in the relevant portion, "the fabric care composition is **substantially free of starch**, and . . . is **substantially free of silicone**." Notably, pending Claim 17 does NOT use the term "essentially free."

Thus Applicants respectfully assert that Office Actions' discussion regarding the use of the term "essentially free" are misplaced. For example, the previous Office Action of 04/24/2003 at paragraph 7 rejects the claims for the use of the term "essentially free." Turning to the present Office Action of 10/01/2003, the Examiner alleges the Applicants point to the definition of "essentially free." This allegation is incorrect. Rather, Applicants in their 9/24/2003 Amendment at page 5 assert that the term "*substantially free of*" is defined at page 5, lines 20-24, of the Specification (referencing WO 00/42139). Moreover, the basis for the use of the term "substantially free of" is found throughout the specification. For example, the Office is directed to original Claim 1 at page 39 of the specification (referencing WO 00/42139).

In view of the foregoing, Applicants request the withdrawal of the rejection.

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Rejection Under 35 USC 103(a) Over WO 98/04772 ("Mooney")

Claims 17-19 have been rejected under 35 USC 103(a) as being unpatentable over WO 98/04772 (hereinafter "Mooney"). Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met per MPEP §2142 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. All three criteria must be met to establish a *prima facie* case of obviousness.

1. Office Actions fails to teach all the claim limitations of the pending claims.

a. Office Action fails to teach "clear or translucent fabric compositions" limitation.

Applicants respectfully assert that Office Action fails to establish that Mooney teaches "clear or translucent fabric care compositions." The 4/24/2003 Office Action cites to the optional ingredient of "hydrotropes" in Mooney at page 14, line 21, as support for the assertion that this provides an implicit teaching of the utility of one-phase (clear) composition. Applicants respectfully assert that the Office Action's assertion is not always true. There are some classes of hydrotropes that increase cloudiness of surfactants while other classes of hydrotropes that decrease cloudiness of surfactants. To support Applicants' assertion, the Office is directed to the article by Roy, B.K. & S.P. Moulik, "Functions of hydrotropes ... in solution with special reference to amphiphile behaviors," *Colloids and Surfaces*, 203 (2002) 155-166 enclosed herein as **EXHIBIT A**. Section 3.3, in the relevant part, at page 158 of the Roy article points out:

Nonionic surfactants and water soluble polymers exhibit clouding at an elevated temperature due to desolvation (dehydration) of their polar residues by the application of heat. Additives may have decreasing or increasing effect on the clouding temperature due to solute-solvent interaction. In this context the behavior of **hydrotrope** may be interesting. In Fig. 4, the dependence of cloud points of [Methyl Cellulose] on the concentration of [hydrotropes] Pr, NaS, Rc, Pg and U is exhibited. It is observed that [hydrotropes] Pr, Rc and Pg significantly DECREASE the [Cloud Point] whereas NaS and U INCREASE it. Such results on TX-100 are presented in Fig. 5. The trends of the effectiveness of the additives are the same as on MC.

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In view of the Roy reference provided herein, Applicants assert that the Office Action's sweeping position that the inclusion of hydrotropes as an implicit teaching of clear compositions is not always true. Moreover, Mooney merely lists hydrotropes as an optional ingredient among dozens of other optional ingredients. Applicants respectfully remind the Office that the burden is on the Office to establish that Mooney teaches clear or translucent fabric compositions. Picking and choosing among optional ingredients fails to meet this burden.

b. Office Action applies an improper "obvious-to-try" standard with respect to the alcohol limitation.

Secondly, Applicants respectfully assert the Office Action ostensibly applies an improper "obvious-to-try" standard in rendering the rejection with respect to the "alcohol limitation"¹ of Claim 16.

The 4/24/2004 Office Action states, in the relevant part, "[I]t is beneficial for spray products to comprise ethanol, isopropanol or a glycol (p. 13, lines 28-30). Discovery of the solvation-effective amount of a solvent amounts to **routine experimentation** and would be obvious to do."

In response, Applicants generally pointed out that Mooney fails to teach or suggest the alcohol limitation of the claims. Moreover Applicants submitted, Mooney does not teach or suggest how much ethanol, isopropanol or glycol should be used in its compositions.

The present 10/01/2003 Office Action rebuts, "[T]he prior art teaches the utility of glycols as a genus, and the Applicants discloses the utility of a number of species of glycols. Such a genus-species relationship constitutes obviousness."

"Obvious to experiment" is not a proper standard for obviousness. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988). "The admonition that 'obvious-to-try' is not the standard under section 103 has been directed mainly at two kinds of error." *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988). "In some cases, what would have been 'obvious-to-try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful

¹ The "alcohol limitation" of Claim 16 claims, in the relevant part, "a solvent comprising water and an alcohol, the alcohol comprising between about 0.01% and 15% of the solvent and having a ClogP of from about 0.15 to about 0.64, the alcohol lacking a center of symmetry."

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result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful." *Id.* This is improper. "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." *Id.*

Applicants respectfully submit the "obvious to experiment" argument presented by the Office Action stands contrary to Federal Circuit jurisprudence. Applicants are not claiming all alcohols but rather, in the relevant part, an "alcohol comprising between about 0.15 to about 0.01% and 15% of the solvent and having a ClogP of from about 0.15 to about 0.64, the alcohol lacking a center of symmetry." Applicants respectfully submit the Office Action fails to establish that Mooney gives an indication of all the parameters of the claimed invention such as:

- i. "0.01% to 15%"
- ii. "ClogP of from about 0.15 to about 0.64" and
- iii. "lacking a center of symmetry."

Applicants also respectfully submit the Office Action fails to provide where in Mooney the direction, among all the many possible choices of alcohols, is likely to be successful in teaching the alcohol limitation in the context of Claim 16.

b. Disclosure of a genus fails to render species obvious.

Applicants respectfully assert the Office Action improperly relies on the genus disclosure of "glycols" in Mooney as teaching the specific alcohol limitation in the context of Claim 16. According to the recent Office Action, "[T]he prior art teaches the utility of glycols as a genus, and the Applicants disclose the utility of a number of species of glycols. Such a genus-species relationship constitutes obviousness." However, according to the Federal Circuit, "The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious." *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994). Applicants respectfully submit the mere disclosure of the genus "glycols" does not by itself render the alcohol limitation of Claim 16, which defines a "species" of alcohol, obvious. The Office Action, Applicants submit, fails to establish the Mooney teaches or suggests something more.

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2. Office Action fails to provide motivation and a reasonable expectation of success.

Lastly, Applicants respectfully submit the Office Action fails to establish a *prima facie* case of obviousness by failing to provide motivation and a reasonable expectation of success with respect to the "clear or translucent fabric care composition" and "alcohol" limitations of Claim 17.

Request for Reconsideration of Restriction Requirement

Per 37 C.F.R. section 1.143, Applicants hereby request reconsideration and withdrawal of the Office Action's restriction requirement under 35 U.S.C. sections 121 and 372. Applicants initially traversed the Office Action's restriction requirement based that the examination of all of the alleged inventions would not pose a serious burden. The recent Office Action finds Applicants' argument as unpersuasive because search and examination of *five* separate and distinct invention wherein the status allegedly having been conceded by Applicants, "is burdensome on its face." The Office Action makes the requirement FINAL.

Applicants respectfully assert that the status of the inventions as alleged separate and distinct does not make the search burdensome of its face. Per section 803 of the MPEP ("Restriction - When Proper") requires two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the invention must be independent or distinct as claimed; AND (B) there must be a serious burden on the examiner if restriction is required. Both requirements must be met for a proper restriction requirement.

According to section 803, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of (a) separation classification, or (b) separate status in the art, or a (d) different field of search. Examiners must provide reasons and/or examples to support conclusions. Applicants respectfully submit that the Office Action fails to make a *prima facie* by failing to provide any explanation of a serious burden as to any one of these three criteria by appropriate explanation.

Moreover, Applicants respectfully submit the Office Action fails in at least in two ways to properly apply a proper unity of invention test to the restriction. Specifically, the Office Action states that the Groups fail to provide a **technical feature**, which fails to make a contribution over the prior art because Group II lacks an **inventive step** in view of Mooney.

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Firstly, the Office Actions impermissibly applies a "patentability" test in imposing the restriction. Per section 806.02 of the MPEP ("Patentability Over the Prior Art Not Considered"), for purposes of a decision on the question of restriction, the claims are ordinarily assumed to be in proper form and patentable (novel and unobvious) over the prior art. Moreover, per section 807 of the MPEP ("Patentability Report Practice Has No Effect on Restriction Practice") patentability report practice has no effect upon the practice of restriction.

Secondly, as to the special technical feature, Applicants submit that all five Examiner's groups share the following technical feature and thus further searching is not needed (much less burdensome):

"A clear or translucent fabric care composition comprising:

- A. from about 01.01 to about 1% of a fabric softening active by weight;
- B. a solvent comprising water and alcohol, the alcohol comprising between about 0.01% and 15% of the solvent and having a ClogP of from about 0.15 to about 0.64, the alcohol lacking a center of symmetry;
- C. and the balance adjunct materials;

wherein the fabric care composition is substantially free of starch, and wherein the fabric care composition is substantially free of silicone. "

Lastly *assuming arguendo*, Applicants have established, in view of the previous discussion with respect 35 U.S.C. section 103, the pending claims are in fact unobvious in view of cited reference. Indeed the Office Action concedes the claims are novel. Thus, the "special technical feature" in fact possess inventive step in view of Mooney.

In view of the foregoing, Applicants respectfully request the restriction requirement be reconsidered and withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. sections 112 and 103; and withdraw the restriction requirement

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under 35 U.S.C. sections 121 and 372. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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January 29, 2004
Customer No. 27752
(Amendment-Response to Office Action 10/01/2003)